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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,316

02/21/2006

Jean-Claude Yvin

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08/22/2007

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EXAMINER

UNDERDAHL, THANE E

ART UNIT

PAPER NUMBER

1651

MAIL DATE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,316	<b>Applicant(s)</b> YVIN ET AL.	
	<b>Examiner</b> Thane Underdahl	<b>Art Unit</b> 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office Action is in response to the Applicant's request for continued examination received 6/7/07. Claims 3-13 are pending. Claims 1 and 2 are cancelled. 3-10 have been amended. Claims 11-13 are new.

#### **Response to Applicant's Arguments— 35 U.S.C § 112**

In the response submitted by the Applicant the 35 U.S.C § 112 rejection of claims 3 and 5 are withdrawn in light of the Applicant's amendment.

#### **Response to Applicant's Arguments— 35 U.S.C § 103**

In the response submitted by the Applicant, the 35 U.S.C § 103 (a) rejection of claims 3-10 over Yvin et al. in view of Bawa et al. were considered but not found persuasive.

The Applicant argues that there is nothing in Yvin et al. that suggests that their solution could be used to "disinfect contact lenses by rinsing them" (Applicant Response, page 8, paragraph 3). The Applicant further argues that while Yvin et al. does use their solution, which Applicant admits is identical to the one required in the instant claim, to replace water in the ocular inserts and replacing the water is not the same as disinfecting the contact lenses by rinsing them (Applicant response, paragraph 4). The Applicant adds that rinsing the contact lenses with the claimed solution disinfects the lenses by preventing the buildup of micro-organism and deposits and removes them from the lens.

The Applicant is reminded that this method contains one active step, that of rinsing the contact lenses with the ionic solution. Since method claims are defined by their steps, art reading

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on rinsing a contact lens with the claimed solution will inherently accomplish the step and thus accomplish the method of disinfecting contact lenses.

While Yavin et al. teaches that their ionic solution can be used to replace water in ocular inserts as well as clean the eye, they fall short of explicitly stating that the solution is used to rinse contact lenses. However as stated in the previous Office Action, Bawa et al. does teach that contact lenses alternatively act as ocular inserts and are made of hydrophilic polymers (Bawa, claim 6, col 2, lines 23-34, and col 7 line 5). One of ordinary skill in the art would recognize, especially one that has had contact lenses made of hydrophilic polymers, that these lenses tend to cause dry eyes because of the lenses lose water throughout the day causing eye dehydration and deposit precipitation, as supported by Refojo (page 38, paragraph 2 and page 39 "Effects of Lens Hydration"). Therefore one of ordinary skill in the art would understand that more water would need to be added to the eye and since the invention of Yvin et al. already has the pH and osmolality of natural tears (Yvin paragraph 39) and is free of preservatives (Yvin paragraph 40) and is already used to wash the eye (Yvin, paragraph 84) and its appendages it would have been obvious to someone skilled in the art to use the solution to wash the contact lens with the solution of Yvin et al. to rehydrate the lenses. Since one of ordinary skill in the art would understand that the act of washing includes the active step of rinsing with the solution limited in the claims, the disinfecting method of claim 3 is met by the combination of Yvin et al. and Bawa et al. with the support of Refojo. Therefore the rejections stands and is repeated below with modifications to address the new claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yvin et al. (WO 01/49304) in view of Bawa et al. (U.S. Patent # 4,931,279). Since WO 01/49304 is in French the U.S. Patent Application # 2003/0152645 is being provided as an English language equivalent since both are derived from PCT/FR00/03709. While this Office Action cites the U.S. Patent Application out of convenience the rejection is made over WO 01/49304.

These claims are drawn to a method to use an aqueous ionic solution obtained from seawater to rinse contact lenses.

Yvin et al. teach a solution of claims 3-13. They teach a solution comprising the following (page 2, paragraphs 29-35 and paragraphs 47-54):

Na<sup>+</sup> from 1300 to 1500 mg/L or preferably from 500 to 1000 mg/L

K<sup>+</sup> from 5000 to 6000 mg/L

Mg<sup>++</sup> from 100 to 200 mg/L

Ca<sup>++</sup> from 40 to 200 mg/L

Cl<sup>-</sup> from 4,500 to 6,000 mg/L

pH of 7.45

osmolality of 309 mOsm/kg

Yvin et al. further teach that the solution can be used "for treating and cleaning the eye and all its appendages" (page 4, claim 1) and "in the form of lotions intended to for washing the eye, in the form of collyria, ophthalmological gels, or to replace the water in ocular inserts" (page

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3, paragraph 84). Yvin et al. does not specifically teach the use of their solution for rinsing contact lenses.

However Bawa et al. teach that contact lenses can alternatively act as ocular inserts (col 12, claim 6). The applicant argues that Bawa et al. only teach “a sustained release polymeric matrix which is moldable to any shape, among the shape of contact lens” (applicant's response page 6, last paragraph). However this is not the case. The patent of Bawa et al. clearly and explicitly intends to use their polymeric matrix to produce contact lenses as ocular inserts as taught in column 7, line 5 and column 2 lines 23-34 of their patent. They also teach that their contact lenses are made of hydrophobic and hydrophilic materials (see abstract).

It would therefore have been obvious for the person of ordinary skill in the art to use the composition of Yvin et al. to rinse contact lenses. The motivation is provided by Yvin et al. who teach a solution for ocular insets with the reasonable expectation of success provided by Bawa et al, who show that contact lenses are considered ocular implants. Therefore, the invention as a whole would have been prima facie obvious at the time of filing in view of the references listed above and as such claims 3-10 are not allowable.

In summary no claims, as written, are allowed for this application.

**In response to this office action the applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06).** Due to the procedure outlined in MPEP § 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 U.S.C. § 102 or 35 U.S.C. § 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is requested to provide a list of all copending U.S. applications that set forth similar subject matter to the present claims. A copy of such copending claims is requested in response to this Office action.

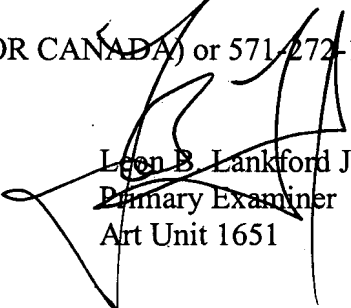
#### CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thane Underdahl whose telephone number is (571) 272-9042. The examiner can normally be reached Monday through Thursday, 8:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached at (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thane Underdahl  
Art Unit 1651



Leon B. Lankford Jr  
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